



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/993,696	12/18/1997	DAVID J. SCHANZLIN	251692002821	5525

7590

06/20/2002

Antoinette F. Konski
McCutchen Doyle Brown & Enersen LLP
Three Embarcadero Center, Suite 1800
San Francisco, CA 94111-4067

EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/993,696

Applicant(s)

SCHANZLIN ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 11-13, 22-35 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-13, 22-35 and 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3738

The "Preliminary Amendment and Request to Declare Interference" paper submitted on January 7, 2002, is not a *bona fide* attempt to respond to the final Office action of May 25, 2001, and appears to be directed to a potential divisional of the present application. The Amendment fails to identify the serial number of the instant application but instead refers to a "New Application". The Response fails to address any of the rejections or specifically point out the support for the added claims (MPEP § 714.02) and does not even correct the minor disclosure errors (Paper No. 24, page 2). Moreover, the newly presented claims are not readable on the elected invention because the claims are now drawn to a method of using the implant rather than to the implant itself (Paper No. 8; MPEP §§ 819 and 821.03). Therefore the Amendment has *not* been considered and the following is repeated from said final Office action.

The disclosure is objected to because of the following informalities: On page 11, line 25, the second occurrence of "a significant meridional length component (224) and" should be deleted. On page 14, line 17, "exceeds" should be --exceed--. The sentence on page 17, lines 25-26, lacks proper syntax. *Numerous other minor errors were noted, including a string of five or six grammar and spelling problems on page 29, lines 10-24.*

Claims 1-5, 11-13, 22-35, and 41-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 4, "its centroidal axis" lacks a proper antecedent basis. Claims 22-24 depend from a canceled claim. Claims 28 and 29 are believed to be vague and indefinite in that --elastic-- should be inserted after "low" or "high" on line 2 of each claim. *Other errors were noted.*

Art Unit: 3738

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5, 11, and 30-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Herrick, US 4,781,187. Regarding claim 32-33: column 1, lines 57-59; abstract.

Claims 3, 4, and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrick, US 4,781,187. Regarding claims 3 and 4, the particular radius of curvature would have been immediately obvious from the intended use of the device, as best illustrated by Figures 3, 4, 7, and 9. Regarding claim 41, although Herrick specifies typical dimensions "on the order of a length of 3.5 to 4.0 millimeters" (column 3, lines 52-56), lengths of less than or equal to 2.5 millimeters would have been obvious in order to accommodate experimentation or practice on rabbits and other small animals or to minimize the length of the corneal incisions.

Art Unit: 3738

Claims 1, 2, 5, 11, 30-35, and 41-46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gonchar et al., "Interlayer Refraction Tunnel Keratoplasty in Correcting Myopia and Astigmatism". Regarding claim 41: page 4, line 16, of the English translation.

Claims 3, 4, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonchar et al. A radius of curvature within the range set forth in present claim 4 would have been immediately obvious from the purpose of the alloimplants (Figure 3). In regard to claim 49, an implant having a length of 2.0 mm or less would have been obvious in order to accommodate a variety of eye sizes and refractive disorders.

Claims 1, 2, 5, 11, 22, 23, 25, 26, and 30-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Civerchia, US 5,213,720. Regarding claim 1, the embodiments shown in Figures 14 and 17 can be inserted into the cornea (Figure 4; column 6, lines 20-21; column 18, lines 9-12) and thus possess a radius of curvature along a centroidal axis of at least 5.0 mm. Regarding claim 23: column 13, lines 28-35. Regarding claim 26: column 12, lines 9-13.

Claims 3, 4, 24, and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Civerchia, US 5,213,720. Regarding claims 3 and 4, the particular radius of curvature would have been immediately obvious from the anatomy depicted in Figure 4. Regarding claim 24, an anti-inflammatory or an anti-thrombogenic would have been an obvious option relative to column 12, lines 9-13, because of the nature of the surgical procedure. Regarding claims 41 and 49, the length of the tabs 132 being less than or equal to 2.0 mm would have been obvious from the drawing (Figure 17) and would have been obvious in order to lessen the trauma to the cornea.

Claims 1, 2, 5, 11, 12, and 27-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lindstrom, US 4,799,931.

Art Unit: 3738

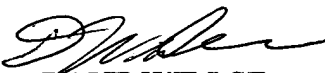
Claims 3, 4, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstrom, US 4,799,931. A value within the range set forth in claim 4 would have been obvious for reasons similar to those cited above. The particular material recited in claim 13 would have been obvious from the list of materials at column 2, lines 9-11.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903 and who is generally available Monday through Thursday during most of each day. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
June 18, 2002


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738